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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,465	04/24/2001	Seth Haberman	0813808.12502	5373
545 7590 06/24/2009				
IP Patent Docketing K&L GATES LLP 599 Lexington Avenue 33rd Floor New York, NY 10022-6030			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2424	PAPER NUMBER
			MAIL DATE 06/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/841,465

Applicant(s)

HABERMAN ET AL.

Examiner

MICHAEL VAN HANDEL

Art Unit

2424

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 21 April 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit 2424

Continuation of 3: Applicant amended claims 1, 16, and 19 to include the phrase "said" personalized advertisement, thus changing the personalized advertisement to have antecedent basis from the prior mentioned personalized advertisement. Applicant further amended claims 8, 10, 12, and 13 to include the phrase "said" personalized advertisement, thus changing the personalized advertisement to have antecedent basis from the prior mentioned personalized advertisements. Since the claims previously did not require that these personalized advertisements be the same advertisements, the claim amendments raise new issues that would require further search and/or consideration.

Continuation of 11: Applicant argues that the examiner fails to provide a prima facie case of obviousness in the Office Action. The applicant specifically argues that the Office Action makes conclusory statements and fails to provide any objective evidence from the prior art or elsewhere that shows that the subject matter recited in claims 1, 16, and 19 would have been obvious to a person having ordinary skill in the art. Applicant further specifically argues that independent claims 1, 16, and 19 would not have been obvious to one having ordinary skill in the art. Applicant still further argues that, because neither Ficco or Klosterman et al. are concerned with saving storage space, neither reference discloses a relationship between storage space and simultaneous data stream transmission and one of ordinary skill in the art would not be motivated to combine Ficco and Klosterman et al. The examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well-known within the prior art that memory space is a constraining factor in design. Despite Ficco's statement that one could store hundreds, thousands, or more advertisements in memory, one of ordinary skill in the prior art would recognize that there still remains a constraint on the number of advertisements to be stored. Klosterman et al. states that advertisements can be selected from various possible locations (stored locally, accessible from the Internet, or available over an alternative channel in real-time) (p. 4, paragraph 45 & p. 6, paragraph 76). The alternative choices reflect tradeoffs in design between bandwidth, storage space, and cost of implementation, for example. Given that memory space is always a constraining factor in design, and that Klosterman et al. provides alternative means of acquiring advertisements, the examiner maintains that one of ordinary skill in the art would have been motivated to combine the references as described in the Office Action.